

**REMARKS**

Claims 1, 2, 4-9, and 45-58 are pending in the present application.

In the office action of November 15, 2006, the following actions were taken:

- (1) Claims 1, 2, 4-9, and 45-58 were rejected under 35 U.S.C. 112, second paragraph; and
- (2) Claims 45, 46, 49-53 and 56-58 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,632,584 (hereinafter "Morgan").

It is respectfully submitted that the presently pending claims be examined and allowed. Applicants submit that each and every amendment herein, and throughout the prosecution of the present application is fully supported by the specification as originally filed, and that no new matter has been added.

**Rejection under 35 U.S.C. § 112, second paragraph**

The Examiner has rejected claim 1, 2, 4-9, and 45-58 under 35 U.S.C. 112, second paragraph. Specifically, the Examiner has asserted that the term "overprinted" is indefinite and that the use of such a term, in the context of the present claim set, would require that the product be an article as opposed to a composition as currently recited. It should be pointed out that the current claim set does not necessarily required that the stabilizer be overprinted, but rather, it can be either admixed or overprinted. Therefore, in order to expedite the prosecution of the current application, the Applicant offers the present broadening amendment to the preamble to include the phrase "composition or article," as both are possible as supported by the body of the claim set as originally filed, i.e. "admixed with or overprinted with respect to . . .". The Applicant respectfully requests that the Examiner withdraw the rejection.

**Rejections Under 35 U.S.C. § 103**

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing the prior art reference, or references combined, teach or

suggest all the claim limitations in the instant application. Further, the Examiner has to establish some motivation or suggestion to combine and/or modify the references, where the motivation must arise from the references themselves, or the knowledge generally available to one of ordinary skill in the art. The Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in any of the rejections.

The Examiner has rejected claims 45, 46, 49-53, and 56-58 as being obvious. Specifically, claims 45, 46, 49-53, and 56-58 were rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan.

#### *The Morgan Reference*

Morgan sets forth a laser-imageable printing system for wet lithographic printing. The composition is modifiable using laser energy, i.e. between hydrophobic and hydrophilic in order to form wet “negatives.” A specific chroman is listed amongst many possible components that can act as a reducing agent for silver ions. See col. 8, lines 37-39.

#### *Claims 45-58*

New claims 45 and 52 were previously added to claim the subject matter from former claim 1, namely the use of chroman as a stabilizer without the requirement of the presence of other listed stabilizers. These particular embodiments have been narrowed in two ways. First, former claim 3 has been incorporated into claim 45. Further, claim 52 has been amended to require that when chroman is present as the stabilizer for the infrared absorber, another component must also be present for providing anti-oxidative properties to the leuco dye. Both claims require chroman function at least as a stabilizer.

Regarding independent claims 45 and 52, Morgan does not teach of the presence of a chroman in a composition that provides the function of stabilizing the infrared absorber, and in the case of claim 45, inhibiting oxidation of the leuco dye. In Morgan, the presence of chroman (among many other possible compound candidates) is used as a reducing agent for silver ions that are present in the disclosed system. **If the chroman composition is used as a reducing agent for silver ions**

(which must be present in Morgan), **then it cannot maintain an appropriate state to function as claimed in claim 45 or claim 52.**

Even if a compound can function in two distinct manners, it is not inherent that the compound will do so in any given situation. For example (unrelated to the present composition, but provided for illustrative purposes), sodium hydroxide can function as a lead remover or an acid neutralizer. Sodium hydroxide will readily dissociate in water. In the presence of lead ions, the hydroxide ion will precipitate out the lead as a solid; thereby functioning as a lead remover. In the presence of hydronium (protonated water), the hydroxide will react with the hydronium producing water, thereby functioning as an acid neutralizer. If the sodium hydroxide is present in a solution containing acid and lead, the hydroxide will react with the acid by the following equation:  $\text{OH}^- + \text{H}_3\text{O}^+ \rightarrow 2 \text{H}_2\text{O}$ . Once the hydroxide has neutralized the acid, the hydroxide is no longer in a form that allows it to remove lead. In other words, the use of sodium hydroxide as an acid neutralizer destroys its ability to function as a lead remover.

Likewise, the chroman composition in the Morgan reference is acting as a reducing agent, which requires the chroman to undergo an oxidation-reduction (Redox) reaction. Such a use destroys the functionality of chroman for the purposes of the present invention. Morgan clearly teaches that chroman is used specifically as a reducing agent for silver ions. See col. 8, line 37 through col. 9, line 20. Therefore, chroman cannot be used as a stabilizing agent and/or inhibiting the oxidation of the leuco dye as presently claimed as chroman would no longer exist in that form. Thus, claims 45 to 58 are believed to be allowable over Morgan. Reconsideration of the rejections over Morgan is respectfully requested on these grounds.

In view of the foregoing, Applicants believe that claims 1, 2, 4-9, and 45-58 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

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Dated this 15<sup>th</sup> day of February, 2007.

Respectfully submitted,



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